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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,404	11/14/2001	Takeshi Kamio	SH-0027US	7029

21254 7590 05/04/2004

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EXAMINER

FIORILLA, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,404

Applicant(s)

KAMIO ET AL.

Examiner

Christopher A. Fiorilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Applicant's election without traverse of Group I, claims 1-17 in Paper dated 12/2/03 is acknowledged.

2. Claims 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper dated 12/2/03.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it contains legal phraseology (i.e. "comprising"). Correction is required. See MPEP § 608.01(b).

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (i.e. the elected method claims).

6. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the manufacture of a perform having a good eccentricity of a core inside

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a preform, does not reasonably provide enablement for the process as generically claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

More specifically, the specification is drawn to a perform which comprises a core (and a clad formed around the core-see e.g. page 1, lines 15-17 and Example 1). The claims do not recite the inclusion of a core inside the porous glass material. The claims must be limited to what the specification discloses which is a process which treats a material comprising a core.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1 and 7 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ishikawa et al. (6,116,055).

Ishikawa et al. discloses a method for sintering a porous glass material. The process disclosed by Ishikawa et al. includes the steps of:

preparing a ring heater (col. 2, line 46) having an opening through which said porous glass material passes, for heating said porous glass material;

selecting said porous glass material having an outer diameter within a predetermined range, said predetermined range being determined based on an inner diameter of the opening of the ring heater; and

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heating said porous glass material in an atmosphere of dehydration gas and inert gas with said ring heater (col. 2, lines 19-20).

Ishikawa et al. also discloses a furnace surrounded by the ring heater as recited in claim 7 (col. 2, lines 45-47).

Note that selecting a porous glass material which fits inside the ring heater meets the “selecting” limitation recited above.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1,7,8,14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al. (6,116,055) in view of Antos et al. (6,289,698).

Ishikawa et al. discloses a method for sintering a porous glass material. The process disclosed by Ishikawa et al. includes the steps of:

preparing a ring heater (col. 2, line 46) having an opening through which said porous glass material passes, for heating said porous glass material;

selecting said porous glass material having an outer diameter within a predetermined range, said predetermined range being determined based on an inner diameter of the opening of the ring heater; and

heating said porous glass material in an atmosphere of dehydration gas and inert gas with said ring heater (col. 2, lines 19-20).

Ishikawa et al. also discloses a furnace surrounded by the ring heater as recited in claim 7 (col. 2, lines 45-47).

Note that selecting a porous glass material which fits inside the ring heater meets the “selecting” limitation recited above.

Ishikawa et al. does not discloses the steps of elongating and drawing the perform to form an optical fiber.

Antos et al. discloses the steps of elongating (e.g. col. 4, line 16) and drawing (e.g. col. 6, line 29) the perform into a fiber. It would have been obvious to one having ordinary skill in the art at the time of the invention to carry out these steps disclosed by Antos et al. on the perform of Ishikawa et al. to obtain a fiber suitable for use.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is (571) 272-1187. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher A. Fiorilla
Primary Examiner
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